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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,727	05/03/2001	Vincent Jen-Jr. Gau	5876P002	8418

7590 12/23/2003  
Thinh V. Nguyen  
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12400 Wilshire Boulevard 7th Floor  
Los Angeles, CA 90025

EXAMINER

TRAN, MY CHAU T

ART UNIT PAPER NUMBER

1639

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/848,727

Applicant(s)

GAU, VINCENT JEN-JR.

Examiner

My-Chau T. Tran

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 705.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-20, 51 and 52 (for reasons of records).

Claim(s) withdrawn from consideration: 53-74.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
**PADMASHRI PONNALURI**  
PRIMARY EXAMINER

### ADVISORY ACTION

1. The amendment filed 11/10/2003 under 37 CFR 1.116 in reply to the final rejection has been considered and has not been entered into the application.

2. The proposed amendments is not deemed to place the application in condition for allowance and will not be entered because:

a. The proposed response is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal because of the art rejections of record would still read on the claims.

b. There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment of the newly added claims (Claims 75-82) is necessary and was not earlier presented.

c. The proposed added new claim limitations were neither searched nor examined in this application and would not overcome the art rejections of record.

d. The proposed newly added claims (Claims 75-82) would raises new issues that would require further consideration and/or search.

3. The rejection under 35 USC 102(b) for claims 1-9, 11-13, and 51-52 as being anticipated by Cozzette et al. is maintained for reasons of records. Applicant's arguments were previously addressed in the Office Action mailed 7/10/2003. The electrodes of Cozzette et al. anticipate the presently claimed electrode (e.g. each of the electrical conductive electrodes consisting of a single layer of an electrically conductive material). The indicator electrode of Cozzette et al. is comprised of a single metal layer (col. 24, lines 52-53) and the reference electrode of Cozzette et

al. is comprised of a single metal layer (col. 25, lines 6-8). Therefore, the biosensor and the electrode structure of Cozzette et al. anticipate the biosensor and electrode structure of the presently claimed invention.

4. The rejection under 35 USC 103(a) for claims 1-2 and 10 as being obvious over Cozzette et al. (US Patent 5,200,051) in view of Heller et al. (US Patent 5,403,700) is maintained for reasons of records. And the rejection under 35 USC 103(a) for claims 1-2 and 14-20 as being obvious over Cozzette et al. (US Patent 5,200,051) in view of Han et al. (US Patent 6,268,161 B1) is maintained for reasons of records. Applicant's arguments were previously addressed in the Office Action mailed 7/10/2003. Applicant's argument that "[C]ozzette does not teach a biosensor with a plurality of electrodes that each consists of a single layer of an electrically conductive material as is claimed. Neither Han nor Heller provide a motivation for modifying the biosensors of Cozzette so each electrodes consists of a single layer of electrically conductive material. As a result, the prima facie case of obviousness is not established and the rejection should be withdrawn". Since Cozzette so each electrodes consists of a single layer of electrically conductive material as stated in the argument for the rejection under 35 USC 102(b) as being anticipated by Cozzette et al. for claims 1-9, 11-13, and 51-52, neither Han nor Heller is use to overcome the deficiency that each electrodes consists of a single layer of electrically conductive material as indicated by applicant. Therefore, a prima facie case of obviousness has been established.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999.

Application/Control Number: 09/848,727

Page 4

Art Unit: 1639

The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00;  
Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

mct

December 18, 2003